

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

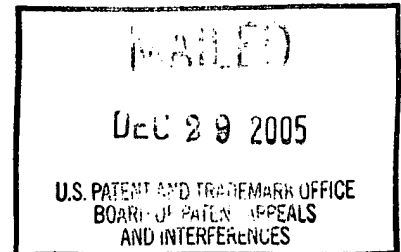
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MONICA R. NASSIF and
PAMELA HELMS

Appeal No. 2005-2378
Application No. 09/659,502

HEARD: OCTOBER 20, 2005



Before SCHEINER, GRIMES, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-11, 13-20,¹ 26-28, and 31.² Claims 1 and 31 are representative of the subject matter on appeal, and read as follows:

1. A method for providing aromatherapy to persons or animals within an ambient environment comprising directly applying a composition consisting of a liquid composition to an inanimate surface to effect a household function selected from the group consisting of surface cleaning, surface shining, degreasing, cleansing, dish washing with soaps, and ironing clothes, the liquid

¹ We note that claim 21 was part of the original appeal, but appellants withdrew that claim from appeal at oral argument.

² Claims 29, 30 and 32 stand withdrawn from consideration as being directed to a non-elected invention. See Appeal Brief, page 5.

composition comprising an aromatherapeutic concentration of an aromatherapeutic essential oil of 0.1 to 20% by weight of the liquid composition, completing the household function, allowing the aromatherapeutic essential oil to remain within the ambient environment to effect aromatherapy on persons or animals within the ambient environment, the solvents in said liquid composition consisting essentially of materials selected from the group consisting of water and alcohols.

31. A method for providing aromatherapy to persons or animals within an ambient environment comprising directly applying a composition consisting of a liquid composition to an inanimate surface to effect a household function selected from the group consisting of surface cleaning, surface shining, degreasing, cleansing, dish washing with soaps, wood finishing and ironing clothes, the liquid composition comprising an aromatherapeutic concentration of an aromatherapeutic essential oil of 0.1 to 20% by weight of the liquid composition, completing the household function, allowing the aromatherapeutic essential oil to remain within the ambient environment to effect aromatherapy on persons or animals within the ambient environment, the solvents in said liquid composition consisting of materials selected from the group consisting of water and alcohols.

Claims 1, 2, 4-20, 26-28 and 31 stand rejected under 35 U.S.C. 102(e) as being anticipated by Cheung.³ In addition, claim 3 stands rejected under 35 U.S.C. § 103(a) as being obvious over Cheung.⁴ Claims 1, 2, 4-10, 26-28 and 31 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ferguson,⁵ and claim 3 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ferguson and Durbut.⁶ We affirm the rejection under 102(e) as being anticipated by Cheung as to claims 1, 2, 4-20 and 26-28, but reverse as to claim 31. We also affirm the rejection of claim 3 under 35 U.S.C. § 103(a) as

³ Cheung et al. (Cheung), U.S. Patent No. 6,177,288, filed September 8, 1999, issued January 23, 2001.

⁴ Claim 21 stood rejected under 35 U.S.C. § 102(b) as being anticipated by Elliot, U.S. Patent No. 5,620,695, issued April 15, 1997. As claim 21 has been withdrawn from appeal, we need not reach the merits of that rejection.

⁵ Ferguson et al. (Ferguson), U.S. Patent No. 6,045,813, issued April 4, 2000.

being obvious over Cheung. We reverse the rejections over the Ferguson patent.

BACKGROUND

According to the specification, “[t]he present invention relates to the field of household systems and compositions for general application around the home or workplace and their use to provide aromatherapeutic and environmentally friendly materials for use around the home or workplace.” Id. at 1. The composition comprises “the household product carrier base, with the essential oil as both an active agent . . . and as an aromatherapeutic ingredient.” Id. at 12.

With respect to the carrier base, the specification teaches:

The compositions useful in the practice of the combined household functions and aromatherapy comprise the oils in combination with carrying agents, including both liquid carriers and blends/solutions of liquid and solid-forming carriers (e.g. polymer binders, waxes, high viscosity agents, volatility reducing agents such as low odor solvents[]), sic] that are less volatile than the essential oils and will retard or control their volatilization. Other additives such as stabilizers (e.g., ascorbic acid for oxidation stability, UV absorbers for UV stability, free radical scavengers for storage stability, etc.; including but not limited to antioxidants, methylparaben, ethylparaben, hydroquinones, betaines, chelating agents particularly for metal ion scavenging, and the like), colorants, aroma modifiers, aroma masking agents, thickening agents (both organic, polymeric, inorganic, natural, and synthetic thickeners such as glycerin, acrylic polymers, corn starch, silica, kaolin clay, bentonite, salt, higher molecular weight oils, oil soaps), eutectic agents to retard volatilization, surfactants (e.g., to assist in liquid film spreading and flow properties; including but not limited to anionic surfactants, cationic surfactants, non-ionic surfactants, Zwitterionic surfactants, and mixtures thereof), sudsing and

⁶ Durbut et al. (Durbut), U.S. Patent No. 6,022,839, issued February 8, 2000.

degreasing agents, solubilizing agents, gels, cleansing or cleaning agents (e.g., ammonia-D for window solutions or ethanol for hygienic surfaces), etc.

Id. at 20.

DISCUSSION

Claims 1, 2, 4-20, 26-28 and 31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Cheung.

We initially note that appellants group the claims into two groups, with Group I comprising claims 1, 2, 4-20 and 26-28, and Group II comprising claim 31. See Appeal Brief, page 11. Claim 1 is representative of the claims of Group I, and we thus focus our analysis of Group I on that claim.

Cheung is cited for teaching “an aqueous concentrated liquid composition for cleaning hard surfaces which blooms when added to a large volume of water, which comprises botanical oil constituents and a binary solvent system which includes at least one organic alcohol and glycol.” Examiner’s Answer, page 4. Cheung teaches the use of botanical oils such as peppermint oil, lavender oil, bergamot oil, rosemary oil and sweet orange oil. See id. Cheung, at Column 12, Table 1, “exemplifies a composition comprising 4% peppermint oil, 12% isopropyl alcohol . . . , water . . . , and other ingredients.” Id. Thus, according to the examiner, Cheung teaches the method of the instant claim 1, as the reference teaches “a method of applying a composition to an inanimate surface for household cleaning purposes, comprising 4% of an aromatherapeutic essential oil, and solvents selected from water or alcohol,” and that “applying the

composition to the surface results in providing aromatherapy to persons within the ambient environment.” Id. at 4-5.

We recognize that in order for a prior art reference to serve as an anticipatory reference, it must disclose every limitation of the claimed invention, either explicitly or inherently. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). As set forth by the examiner, Cheung sets forth all of the limitations of claim 1, and the rejection of claims 1, 2, 4-20 and 26-28 under 35 U.S.C. § 102(e) is affirmed.

Appellants argue that “[a]s Cheung requires additional solvents beyond the possibility of water and alcohol, and the present claims exclude any solvent other than water and alcohol, Cheung does not anticipate the claims.” Appeal Brief, page 18. According to appellants, the additional solvents of Cheung are required for “an essential function to the practice of the invention,” and “[a]s this material is present in an amount necessary to provide this essential function of Cheung [], the presence of that material is specifically excluded by the limitation of the solvents by the phrase ‘consisting essentially of.’” Id.

Claim 1 recites that “the solvents in said liquid composition consisting essentially of materials selected from the group consisting of water and alcohols.”

“Consisting essentially of” is a transition phrase commonly used to signal a partially open claim in a patent. Typically, “consisting essentially of” precedes a list of ingredients in a composition claim or a series of steps in a process claim. By using the term “consisting essentially of,” the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted

ingredients that do not materially affect the basic and novel properties of the invention. A "consisting essentially of" claim occupies a middle ground between closed claims that are written in a "consisting of" format and fully open claims that are drafted in a "comprising" format.

PPG Industries v. Guardian Industries Corp., 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). In this case, the basic and novel properties of the invention of claim 1 are aromatherapeutic effects in the use of claimed composition in a household function. The additional solvents added by Cheung do not materially affect those basic and novel properties, and thus Cheung anticipates the composition of instant claim 1. Appellants, in arguing that the additional solvents of Cheung are required for an essential function to the practice of the invention, are incorrectly focusing on the composition of Cheung rather than focusing on the invention of claim 1, and thus fail to explain how the additional solvents of Cheung affect the basic and novel properties of the invention of claim 1. Moreover, the specification does not provide a definition of "consisting essentially of" that would exclude the additional solvents taught by Cheung.

As to claim 31, appellants argue that "[c]laim 31 further limits claim 1 language by reciting that the solvent consists of water or alcohol," thus that language "excludes the additional solvent material of the reference." Appeal Brief, page 18.

We agree, and the rejection of claim 31 under 35 U.S.C. § 102(e) is reversed.

The examiner contends that “[t]he herein claimed liquid composition does not exclude any components because it recites the transitional phrase ‘comprising.’” Examiner’s Answer, page 11. Claim 31, however, limits the solvent to water and alcohols by reciting that “the solvents in said liquid composition consisting of materials selected from the group consisting of water and alcohol,” thus excluding the solvent composition of Cheung. See Mannesmann Demag Corp. v. Engineered Metal Products Co., 793 F.2d 1279, 1282, 230 USPQ 45, 46-47 (Fed. Cir. 1986) (accepting the district court’s observation that the phrase “consisting of,” when not appearing in the preamble, but appears in a clause in the body of the claim, limits only the element set forth in that clause).

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being obvious over Cheung.

Cheung is applied as above. The examiner notes, however, that while Cheung “teaches that the concentrate composition is particularly useful in the cleaning of surfaces composed of ceramics, glass and metals,” the reference “lacks an exemplification of cleaning these specific surfaces.” Examiner’s Answer, page 7. The examiner, concludes, however, “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify a method of cleaning ceramic, glass or metal using the composition exemplified by Cheung [] because Cheung [] teach[es] their compositions as particularly useful for cleaning ceramic, glass and metal.” Id.

Appellants reiterate their arguments made in response to the rejection under 35 U.S.C. § 102(e) over Cheung, and thus this rejection is affirmed for the reasons set forth above with respect to that rejection.

Claims 1, 2, 4-20, 26-28 and 31 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by Ferguson.

Ferguson is relied upon for teaching “lotions and gels with active ingredients in beads,” in which a surface is treated “with an active ingredient comprising providing a carrier liquid, disbursing in the carrier liquid a multiplicity of visible friable beads, each containing from about 0.5 to about 5% by weight active ingredient for treating the surface, dispensing the carrier with beads through a dispenser pump onto a surface; and using the carrier with beads on the surface, at least one of the steps of dispensing or the step of using the beads on the surface, causing fracturing of the beads to spill their content and mix it with the carrier liquid.” Examiner’s Answer, pages 7-8. Ferguson also teaches that an essential oil may be used as the active ingredient, and also teaches the use of alcohol and water as carriers. See id. at 8.

According to the examiner, “[t]he reference lacks an exemplification of effecting a household function,” but concludes that “[i]t would have been obvious . . . to use the teachings of Ferguson [] to exemplify a method of treating a surface for household cleaning . . . because Ferguson [] specifically teach their method for household cleaning and because of the expectation of achieving a cleansing product that smells good.” Id.

Appellants argue that the method claims require that a “composition consisting of a liquid composition is applied to surfaces,” and thus “clearly exclude the solid shells required by Ferguson.” Appeal Brief, page 22 (emphasis in original). The examiner responds that “[t]he liquid composition herein claimed does not exclude any other ingredients be incorporated into the same.” Examiner’s Answer, page 13. Claim 1, however, recites a “composition consisting of a liquid composition,” and the use of the phrase “consisting” of in that manner limits the composition to a liquid, thus excluding the friable solid shells of Ferguson.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Ferguson and Durbut.

Ferguson is relied upon as above. Durbut is relied upon for teaching liquid cleaning compositions comprising essential oils, wherein the compositions may be used to clean hard surfaces, such as painted woodwork, tiled walls, bathtubs and metal surfaces. See Examiner’s Answer, page 9. As Durbut fails to remedy the deficiencies of Ferguson, as discussed above, this rejection is also reversed.

OTHER ISSUES

The claims are drawn to a method of aromatherapy using an essential oil and a solvent selected from water and alcohols. We note that English Lavender Water is “perhaps the oldest known and most frequently used lavender

products." Jane Austen Centre Online Magazine.⁷ One of the recipes consists solely of water, alcohol and essential oil of lavender. See id. Other recipes for Lavender Linen water consist of lavender and spearmint essential oil, vodka and distilled water. Lucinda Jenkins, Lavender recipes, Glenbrook Farms.⁸ If this application is subject to further examination, the examiner should consider whether any of the claims are anticipated by the well-known use of lavender water in, e.g., ironing linens.

CONCLUSION

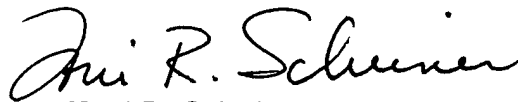
The rejection of claims 1, 2, 4-20 and 26-28 under 35 U.S.C. 102(e) as being anticipated by Cheung is affirmed, but the rejection is reversed as to claim 31. In addition, the rejection of claim 3 under 35 U.S.C. § 103(a) as being obvious over Cheung is affirmed. We reverse the rejections over the Ferguson reference. Finally, we have raised other issues that may be relevant to the patentability of the claims.

⁷ <http://www.janeausten.co.uk/magazine/index.html?pid=137&step=4>, printed November 10, 2005.

⁸ <http://www.glenbrookfarm.com/herbs/lavrecipe.html>, printed November 10, 2005; see also <http://aromathyme.com/lavender-essential-oil.html>, printed November 10, 2005; http://health.groups.yahoo.com/group/Bath_and_Body/message/2475, printed October 12, 2005 (discussing adding essential oils to water for the purposes of cleaning).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; REVERSED-IN-PART



Toni R. Scheiner)
Administrative Patent Judge)



Eric Grimes)
Administrative Patent Judge)



Lora M. Green)
Administrative Patent Judge)

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